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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/208,814	12/09/1998	R. PADMANABHA RAO	939V-310-1-1	8650

7590 10/22/2002

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EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/208,814

Applicant(s)

RAO

Examiner

Son P Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-62 and 65-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-62, 65-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 60-62, 65-68 have been considered but are moot in view of the new ground(s) of rejection.

Priority

2. This application appears an error to constitute a continuation-in-part of the prior Application No. 08/451,264, filed May 26, 1995 since the patent date of Application No. 08/451,264 is August 17, 1998, which is prior to the filing date of this application (December 09, 1998). Therefore, claiming the benefit of a prior Application No. 08/451,264 is improper.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 60-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Rao (WO 96/37983)- herein after referred to as '983-

Regarding claims 60-62, 65-68, claims 60-62, 65-68 of ' 983 respectively recites all limitations being in claims 60-62, 65-68.

Double Patenting

5. Claims 60 - 62 and 65 – 68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable Rao (U.S. 5,940,738) - hereinafter referred to as ' 738 - in view of Rao (WO 96/37983)- hereinafter referred to as '983-.

Regarding claim 60, claim 15 of '738 recites a digital information distribution system comprising:

a digital information stream server comprising:

means for storing a digital information stream of predetermined duration;

network adaptation means for transmitting digital information onto a first communication network on a predetermined channel;

request receiving means for receiving requests for the digital information stream from the first communication network;

scheduling means for directing the digital information stream to the network adaptation means for transmission over the first communication network on the predetermined channel at a predetermined time, if a request for the digital information stream is received by the request receiving means; and
opportunistic programming means for directing digital information to the network adaptation means for transmitting over the first communication network only if the digital information stream is not being transmitted (see col. 25, line 1 – col. 26, line 7).
However, Rao (US 5,940,738) does not explicitly disclose a “network interface” comprising:

request receiving means for receiving request originally for the subscriber units;
and

request relaying means for relaying only requests from privileged subscriber units for the digital information stream to the digital information stream server; and

means for relaying the digital information stream from the “first communication network” to the requesting ones of the privileged subscriber units via the “second communication network.”

Claim 60 of '983 (lines 22-36) recites a network interface comprising:
request receiving means for receiving request originally for the subscriber units; and
request relaying means for relaying only requests from privileged subscriber units for the digital information stream to the digital information stream server; and

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means for relaying the digital information stream from the "first communication network" to the requesting ones of the privileged subscriber units via the "second communication network. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '738 to incorporate a network as taught in '983 in order to reduce bandwidth so that increase efficiency of transferring data between head end and subscriber units.

Regarding claim 61, claim 61 of '983 (lines 37-49) recites the scheduling in the rejection of claim 60 further comprising means for:

if a request for the digital information stream is received prior to a predetermined time, initiating transmission of the digital information stream starting at a beginning of the digital information stream over the predetermined channel at the predetermined time; and

if the request for the digital information stream is received after the predetermined time, initiating transmission of the digital information stream at a point in the digital information stream determined relative to the predetermined time so that the digital information stream ends the predetermined duration after the predetermined time.

Regarding claim 62, claim 62 of '983 (lines 1-2) recites the first communication network is a hierarchical network (see col. 24, lines 1-4).

Regarding claim 65, claim 65 of '983 (lines 1-4) recites the opportunistic programming means transmits digital information via the channel only upon request of a subscriber unit when the digital information stream is not being transmitted.

Regarding claim 66, claim 66 of '983 (lines 1-4) recites a system as discussed in the rejection of claim 60 wherein the opportunistic program means transmits digital information via the channel whenever the digital information stream is not being transmitted.

Regarding claim 67, claim 67 of '983 (lines 1-3) recites a system as discussed in the rejection of claim 60 wherein the digital information transmitted by the opportunistic programming means comprises an alternative video program.

Regarding claim 68, claim 68 of '983 (lines 1-3) recites the system as discussed in the rejection of claim 60 wherein the digital information transmitted by the opportunistic programming means comprises computer data.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-0377.

Son P. Huynh
October 14, 2002


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
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